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OFFICE OF PETITIONS

In re Patent No. 7,186,800 :
Gentz et al. :
Application No. 09/518,931 : DECISION ON REQUEST FOR
Issue Date: March 6, 2007 : RECONSIDERATION OF
Filed: March 3, 2000 : PATENT TERM ADJUSTMENT
Attorney Docket No. PF454P1 : UNDER 37 CFR 1.705(d)

This is a decision on the "RESPONSE TO THE DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT," filed September 24, 2010, requesting that the revised patent term adjustment determination for the above-identified patent be changed from one thousand three hundred thirty-eight (1338) days to one thousand six hundred eighty-six (1686) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **DISMISSED**.

BACKGROUND

By application for patent term adjustment timely filed October 11, 2006, patentee challenged the initial determination of Patent Term Adjustment under 35 U.S.C. 154(b)¹ in this application of 1226 days (Notice mailed July 12, 2006) on the basis that both the period of adjustment of 1146 for Office delay in responding to patentees' reply and the period of

¹ This application became eligible for patent term adjustment for examination delay by virtue of the filing of a continuing prosecution application on October 25, 2000.

adjustment of 206 days for Office delay due to an interference delay should not be entered as the periods overlapped.

By decision mailed January 9, 2007, the Office removed the period of delay of 1146 days on the basis that there was no examination delay within the meaning of 37 CFR 1.702(a)(2). It was concluded that by the Letter Regarding Suspension mailed January 17, 2002 in response to, and within four months of, patentees' filing of the amendment after final on November 20, 2001, there was no examination delay. In addition, the decision entered a total of 725 days² (including the previously accorded 206 days) for examination delay pursuant to 1.702(c) for those periods during which issuance of the patent was delayed due to interference proceedings under 35 U.S.C. 135(a).

On March 6, 2007, the patent issued with a revised patent term adjustment of 622 days.

By request for reconsideration timely filed March 7, 2007, patentees renewed their request for correction of the initial determination of patent term adjustment. By decision mailed October 1, 2007, the request for reconsideration was dismissed and the previous decision affirmed³.

On December 3, 2007, patentees timely filed a response to the decision on the request for reconsideration of patent term adjustment. By decision mailed August 27, 2010, the decision was granted to the extent that the period of adjustment of Office delay under 37 CFR 1.702(b)(in light of Wyeth) was corrected to 716 days. The prior decisions that there was no examination delay within the meaning of 37 CFR 1.702(a)(2) and

² With respect to the suspensions in this case, it was concluded that the periods of adjustment are properly 306 days for the period from January 16, 2002 to November 18, 2002, 206 days for the period from July 17, 2003 to February 8, 2004, and 213 days for the period from June 9, 2004 to January 8, 2005 for a total of 725 days.

³ First, it was concluded that the Letter Regarding Suspension mailed January 17, 2002 was a notification under 132 and properly stopped the clock for determining examination delay pursuant to 37 CFR 1.702(a)(2). Thus, there was no Office delay within the meaning of 1.702(a)(2) for taking in excess of four months to respond to the "reply under 35 U.S.C. 132³" filed by applicants on November 20, 2001. Secondly, it was concluded that the period of adjustment for Office delay due to interference proceedings, pursuant to 37 CFR 1.703(c)(2), was correctly calculated as 725 days.

that the period of delay under 37 CFR 1.702(c) for suspension totalled 725 days continued to be affirmed.

On February 15, 2011, the Office issued a certificate of correction correcting the patent term adjustment in this patent from 622 to 1338 days.

OPINION

Patentees argue that the determination of 1338 days remains in error in that pursuant to 35 U.S.C. § 154(b) the Office failed to issue a patent within three years of the actual filing date of the above-referenced application in accordance with 37 CFR § 1.702(b) and failed to take certain action within the time frames specified in 37 CFR § 1.702(a).

With respect to § 1.702(a), predicated on the previous argument that the Letter Regarding Suspension mailed January 17, 2002 is not, as considered by the Office, an Office action within the meaning of 35 U.S.C. 132 and thus, did not stop the Office's clock for calculating examination delay in taking action on their reply filed November 20, 2001, patentees continue to maintain entitlement to 1,146 days of examination delay for Office delay in not taking action on their reply filed November 20, 2001 until May 9, 2005.

This argument has been considered, and it has been determined that no change will be made to the calculation of 0 days for Office delay in taking action in response to the reply filed November 20, 2001. On January 17, 2002, within four months of the filing of the reply, the Examiner mailed the Office action, including the following actions entering of an amendment, withdrawal of rejections of claims and noting that all claims were allowable, except due to an interference, ex parte prosecution of the application was suspended. The fact that a new Office action by a new Examiner entering new rejections was mailed on May 9, 2005 after the termination of the suspension does not negate the fact that an Office action was mailed on January 17, 2002.

It is noted that Patentees were accorded 725 days of patent term adjustment for the periods of suspension. 37 CFR 1.702(b)(2) provides that:

The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(2)(i) The number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension;

As such, the 725 days of suspension were not included in the B delay.

With respect to § 1.702(b), patentees argue that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), is 827 days. This 827 day period is calculated based on the application having been filed under 35 U.S.C. 111(a) on December 6, 2001, and the patent having not issued until March 13, 2007, three years and 1464 days later. The discrepancy between the Office's calculation of 716 days and patentees' of 827 days of B delay is based on the calculation of overlap. The discrepancy arises from the difference in calculation of the A delay discussed above and the period of Office delay of 725 days for the periods of suspension. Given the Office's position, the B delay remains 716 days.

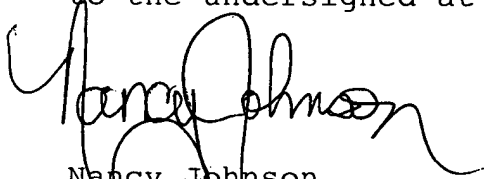
In view thereof, the Office affirms that the correct revised determination of patent term adjustment at the time of the issuance of the patent is 1338 days. The Certificate of

Correction was properly issued and no further action is required.

CONCLUSION

The Office acknowledges that patentees previously authorized payment of the \$200 fee set forth in §1.18(e). However, a review of the finance records reveals that this fee was never charged. The fee is now being charged.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the typed name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions